

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Pettitt (TI-28576)

Serial No. 09/945,295

Filed: August 31, 2001

For: Automated Color Matching for Tiled Projection System

Conf. No. 2019

Group Art Unit: 2625

Examiner: Hung

REQUEST FOR RECONSIDERATION UNDER RULE 116

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Dear Sir:

This paper is presented in response to the Office Action mailed November 30, 2006. Reconsideration of this application considering these remarks, and withdrawal of the final rejection after such reconsideration, are respectfully requested.

Claims 1, 4 through 13, 16 and 18 remain in this case. No claim is amended in this paper.

Claims 1, 4, 5, 10, 12, 13, and 16 were finally rejected under §103 as unpatentable over the Oguchi et al. reference¹ in view of the Kunzmann et al. patent². Claim 6 was finally rejected under §103 as unpatentable over the Oguchi et al. reference in view of the Kunzmann et al.

¹ U.S. Patent No. 6,340,976 B1, issued January 22, 2002 to Oguchi et al., from an application filed August 17, 1999 via PCT International Application PCT/JP98/01709 filed April 15, 1998.

² U.S. Patent No. 6,054,832, issued April 25, 2000 to Kunzmann et al.

patent, and further in view of the Noguchi reference³. Claim 7 was finally rejected under §103 as unpatentable over the Oguchi et al. reference in view of the Kunzmann et al. patent, and further in view of the Yoshikuni reference⁴. Claims 8 and 9 were finally rejected under §103 as unpatentable over the Oguchi et al. reference in view of the Kunzmann et al. patent, and further in view of the Appel reference⁵. Claims 11 and 18 are finally rejected under §103 as unpatentable over the Oguchi et al. reference in view of the Kunzmann et al. patent, and further in view of the Gibson reference⁶.

In the Amendment of October 13, 2006, Applicant urged that the Kunzmann et al. patent is not available as prior art against the claims in this case for purposes of the §103 patentability determination, based on a Declaration⁷ by Applicant, and because of the common assignment of this application with the Kunzmann et al. patent. The Examiner found that this Declaration was ineffective to eliminate the Kunzmann et al. patent as prior art, because common ownership of the Kunzmann et al. patent and of the invention claimed in this application *as of the time this invention was made* was not established. As such, the Examiner found that the Kunzmann et al. patent was still available as a reference under §102(e) for purposes of the §103 patentability determination, and asserted that its effective date as a reference is May 30, 1997, which predates the date of conception established by Applicant's Declaration.

Submitted herewith is a copy of an agreement between Applicant and Texas Instruments Incorporated ("TI"), dated January 16, 1984, and entitled "Assignment of Inventions and Company Information Agreement" ("the Agreement"). In the Agreement, Applicant agreed, *inter alia*, to:

disclose promptly, completely, and in writing to TI and I hereby assign and agree to assign . . . any and all inventions, processes, diagrams, methods, apparatus, or any improvements (all hereinafter collectively called "inventions") whatsoever,

³ U.S. Patent No. 6,101,272, issued August 8, 2000.

⁴ English language abstract of Japan Patent Publication 02-001351, dated January 5, 1990, based on an application filed by Yoshikuni.

⁵ U.S. Patent No. 5,337,410, issued August 9, 1994 to Appel.

⁶ U.S. Patent No. 5,253,043, issued October 12, 1993 to Gibson.

⁷ The Examiner correctly surmised, in the Office Action of November 30, 2006, that this Declaration was submitted pursuant to 37 C.F.R. §1.131.

discovered, conceived, and/or developed, either individually or jointly with others, during the course of my employment with TI . . . provided that the subject matter is one within a field of interest of TI.⁸

The Declaration filed with the Amendment of October 13 established that Applicant was employed by Texas Instruments Incorporated at least as early as the date of conception, and the dates of activity toward reduction to practice, of the invention claimed in this application. That Declaration also establishes that Applicant disclosed his invention to the Patent Department of Texas Instruments Incorporated, as contemplated by the Agreement, and that the subject matter of this invention was the subject of efforts and actions of Texas Instruments Incorporated toward the development of a product of Texas Instruments Incorporated (*e.g.*, the “DDP 1000 DMD Controller”). As such, the subject matter of this application is clearly “within a field of interest of TI”, pursuant to the Agreement.

Accordingly, Applicant submits that the invention claimed in this application was subject to an obligation of assignment to, and was in fact assigned to, Texas Instruments Incorporated at the time that it was made. And because the Kunzmann et al. patent was assigned to Texas Instruments Incorporated as of May 27, 1997 (as established by the assignment recorded in the Patent and Trademark Office under reel 009229, frame 0030), Applicant submits that the invention claimed in this application and the Kunzmann et al. patent were, at the time the invention claimed in this application was made, owned by the same legal person or subject to an obligation of assignment to the same legal person, namely Texas Instruments Incorporated.⁹

Therefore, Applicant submits that the Kunzmann et al. patent is not available as prior art under §102(e), for purposes of the patentability determination under §103, against the claims in this case.

This application claims priority to provisional application No. 60/229,625, filed August 31, 2000, and is entitled to an effective filing date of August 31, 2000. Accordingly, the Kunzmann et al. patent is not available as a reference under §102(b) against the claims in this

⁸ Assignment of Inventions and Company Information Agreement, paragraph I.A.

⁹ 35 U.S.C. §103(c)(1).

case, for any purpose, because its issue (and publication) date is less than one year before the effective filing date of this application.

The Kunzmann et al. patent was published on its issue date of April 25, 2000, which predates the filing date of this application. Applicant again submits that his invention was made prior to April 25, 2000, as established by the Declaration of Applicant submitted with the Amendment of October 13, 2006. Therefore, Applicant submits that the Kunzmann et al. patent is not available as prior art against the claims in this application under §102(a), for any purpose.

The Kunzmann et al. patent is not prior art to the claims in this application under any of subsections §102(c), §102(d), §102(f), or §102(g), for any purpose including for the purpose of the §103 patentability determination.

For these reasons, Applicant submits that the Kunzmann et al. patent is not available as prior art against the claims in this application under any subsection of §102, for purposes of the §103 patentability determination.

As noted above, each basis of the final rejection against the claims in this case is a §103 patentability rejection, and is based on the combination of the Kunzmann et al. patent with other prior art. Because the Kunzmann et al. patent is not available as prior art for purposes of the §103 patentability determination, each basis of rejection in this case no longer stands. Applicants therefore respectfully submit that the rejection of all claims in this case is overcome by the Declaration filed with the Amendment of October 13, as supplemented by the copy of the Agreement submitted with this paper.

For these reasons, Applicant submits that all claims are in condition for allowance. Favorable reconsideration of this application, in light of this amendment and these remarks, is therefore respectfully requested.

Respectfully submitted,
/Rodney M. Anderson/
Rodney M. Anderson
Registry No. 31,939
Attorney for Applicant

Anderson, Levine & Lintel, L.L.P.
14785 Preston Road, Suite 650
Dallas, Texas 75254
(972) 664-9554